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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,980	01/29/2004	Itzhak Bentwich	050992.0201.02USCP	1979
37808	7590	10/20/2008		
ROSETTA-GENOMICS c/o PSWS 700 W. 47TH STREET SUITE 1000 KANSAS CITY, MO 64112			EXAMINER ANGELL, JON E	
			ART UNIT 1635	PAPER NUMBER
			MAIL DATE 10/20/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,980	Applicant(s) BENTWICH, ITZHAK	
	Examiner J. E. Angell	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-72 and 89-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-72 and 89-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/29/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/08 has been entered.
2. Claims 69-72 and 89-96 are currently pending and are addressed herein.
3. Applicant's arguments are addressed on a per section basis. The text of those sections of Title 35, U.S. Code not included in this Action can be found in a prior Office Action. Any rejections not reiterated in this action have been withdrawn as being obviated by the amendment of the claims and/or applicant's arguments.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 7/29/08 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC §§ 101 and 112

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 69-72 and 89-96 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or, alternatively, a well established utility.

The claims are drawn to isolated nucleic acid sequences. A review of the specification, which is over 8,4000 pages long, finds general assertions and statements that the present invention relates to a group of bioinformatically detectable novel genes, which Applicant refers to as "genomic address messenger" or "GAM" genes, which are believed to be related to the micro RNA (miRNA) group of genes.

The specification teaches that Micro RNAs (miRNAs), are short ~22nt non-coding regulatory RNA oligonucleotides, found in a wide range of species, believed to function as specific gene translation repressors, sometimes involved in cell-differentiation.

The specification makes general statements that the bioinformatically detectable sequences, GAMs, and the miRNAs they may encode may have utility for regulating target genes and possibly for treating disease.

However, the specification provides no direct or indirect evidence for any specific, substantial, or credible utility of the instantly claimed RNAs encoded by SEQ ID NO:142700 (or an RNA equivalent). There is no disclosure indicating or suggesting that SEQ ID NO:142700 has itself ever been isolated or examined in any way, nor any evidence that the claimed RNA has, in fact, been isolated or prepared or studied or examined under any conditions. Any asserted utility for the claimed sequences appears to be merely speculation based on "bioinformatics," homology, and secondary structure predictions suggesting that the encoded RNAs are miRNAs because they have a miRNA-like hairpin structure and some degree of sequence homology to

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some unidentified target sequence. On this basis, and since other miRNAs are known to have gene expression modulating properties, Applicant appears to be asserting that the bioinformatically detectable sequences, or GAMs, such as the RNAs encoded by SEQ ID NO:142700 also have utility.

However, that utility has not been clearly defined, nor does the prior art search of SEQ ID NO:142700 provide any substantial evidence to show that the sequences have a credible utility.

Applicant has not shown, and there is no evidence in the prior art to suggest, that the nucleic acids now claimed are expressed in any cell whatsoever. Indeed, the asserted utility and target gene of this and thousands of other miRNA-like sequences appears to be based purely on bioinformatic methods for predicting RNA folding and potential gene targets.

Krutzfeldt et al. (2006) *Nature Genetics* 38:514-519 state that, in general, the basis for these types of prediction programs is the degree of sequence complementarity between a miRNA and a target UTR, including the presence of a consecutive string of base pairs at the 5' end of the miRNA known as a 'seed' or 'nucleus', and the cross-species conservation of this binding site. On average, 200 genes are predicted to be regulated by a single miRNA. The authors further state that reviewing the data provided by these algorithms determining candidate targets uncovers the entire gamut of gene categories, such as transcription factors, protein kinases, vesicular trafficking molecules and membrane receptors, suggesting that there is no apparent bias towards one particular function.

Accordingly, while the ability to predict hairpin-like structures and potential gene targets from genomic sequence information appears to be within the state of the art, Krutzfeldt et al. teach that validating the true biological function of any predicted miRNA sequence requires

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analyzing miRNA expression patterns, as well as testing the effects of miRNA overexpression and underexpression under different conditions in living cells *in vitro* and *in vivo*.

Thus, while these methods, too, are within the level of skill in the art, Applicant has presented no evidence that any of these validation techniques have, in fact, been carried out with regard to the instantly claimed sequences. That is, no evidence can be found verifying or even suggesting that the sequences encompassed by the claims, including SEQ ID NO:142700, RNA equivalents, etc., actually gives rise to miRNAs in any cell or organism.

The specification generally asserts that a utility of the novel oligonucleotides of the present invention is detection of GAM oligonucleotides and of GR (Genomic Record) polynucleotides—that diagnosis of expression of oligonucleotides of the present invention may be useful for research purposes, in order to further understand the connection between the novel oligonucleotides of the present invention and disease and disease diagnosis and prevention purposes, and for monitoring disease progress.

However, none of these asserted uses meet the three-pronged requirement of 35 U.S.C. § 101 regarding utility, namely, that the asserted utility be credible, specific and substantial.

Neither the instant specification nor the prior art presents any evidence that instant SEQ ID NO:142700, much less the claimed RNA equivalents thereof have any specific biological function. No evidence or information is found either in the specification or the prior art linking SEQ ID NO:142700 or its RNA with the modulation of any bacterial or mammalian gene or with the conditions that render cells or hosts susceptible to any disease or disorder, for example. No convincing evidence is found teaching any biological function for SEQ ID NO:142700 at all. In fact, no evidence is found suggesting or stating that the RNAs encoded by SEQ ID NO:142700

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have been made, isolated, cloned, detected, expressed, or even analyzed in any living cell *in vitro* or *in vivo*.

In summary, no biological or biochemical function has been assigned to the claimed sequences, apart from the general assertions that it, like the thousands of other sequences described in the sequence listing, may correspond to an miRNA and have some direct or indirect relation to human biology and/or cell function.

Thus, the proposed utility of the sequences as therapeutic targets or agents, research tools, material resources for preparing diagnostic probes, vectors, and systems, are simply starting points for further research and investigation into potential practical uses of the claimed nucleic acid sequences.

Brenner v. Manson, 148 U.S.P.Q. 689 (U.S. 1966)

The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. Unless and until a process is refined and developed to this point—where specific benefit exists in currently available form—there is insufficient justification for permitting an applicant to engross what may prove to be a broad field.
...a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.

Thus, the specification does not teach a specific, substantial, or credible utility for claimed sequences. No evidence been presented showing or suggesting that any small RNAs are actually expressed by SEQ ID NO:142700 in any cell, and, if so, what function these sequences perform.

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Claims 69-72 and 89-96 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or, alternatively, a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Response to Arguments

5. Applicant's arguments filed 7/29/2008 with respect to the rejection of claims under 35 U.S.C. 101 and 112, first paragraph, have been fully considered but are not persuasive.

It is noted that Applicants have submitted data as part of their response to the rejection of claims under 35 U.S.C. 101/112, however, the evidence was not submitted as part of a Declaration. As such the data is considered to be Attorney's arguments. In response to applicant's argument which relies on the submitted data, it is respectfully noted that attorney arguments cannot take the place of evidence. See MPEP Patent Rule § 1.132 (Affidavits or declarations traversing rejections or objections), which indicates:

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

In the instant case, the evidence submitted to traverse the rejection must be by way of an oath or declaration under section 1.132. Therefore, the evidence relied upon but not presented as a Declaration under section 1.132 has not been considered. It is noted that should applicants submit the evidence as part of a proper and timely filed Declaration, it will be considered.

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Furthermore, it is acknowledged that an asserted utility is credible if the assertion is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided. An assertion is credible unless (i) the logic underlying the assertion is seriously flawed, or (ii) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion. Furthermore, the asserted utility of using the claimed nucleic acids for modulating expression of specific mRNA targets has been considered and the disclosure of paragraph 0265 has been fully considered. However, considering the teaching of Krutzfeldt et al. (see above) validating the true biological function of any predicted miRNA sequence requires analyzing miRNA expression patterns, as well as testing the effects of miRNA overexpression and underexpression under different conditions in living cells *in vitro* and *in vivo*. Therefore, based on the teaching of the prior art, further experimentation is necessary in order to determine if the sequences encompassed by the claims encode functional miRNAs. That is, based on the evidence of record, it cannot be said that it is more likely than not that the claimed sequences encode (or are themselves) sequences which can inhibit expression of a target sequence.

Therefore, Applicants arguments, as they pertain to the rejections as they now stand, are not persuasive.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is 571-272-0756. The examiner can normally be reached on Monday-Thursday 8:00 a.m.-6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. E. Angell/
Primary Examiner, Art Unit 1635